REMARKS

Claims 1-18 and 22-83 are pending and under examination in the application. Claims 8-18, 22, 27-32, 50-51, 61-66 and 79 have been amended to overcome the rejections for indefiniteness under 35 U.S.C. § 112, second paragraph by deleting certain uses of the terms "approximately" or "about." No new matter has been introduced by these Amendments.

I. Rejections under 35 U.S.C. § 112

Claims 8-18, 22, 27-32, 50-51, 61-66 and 79 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although applicants do not agree with or concede the merits of these rejections, claims 8-18, 22, 27-32, 50-51, 61-66 and 79 have been amended as set forth above to overcome these rejections.

II. Rejections under 35 U.S.C. § 103

Claims 1-18 and 22-83 stand rejected as allegedly being obvious and unpatentable under 35 U.S.C. § 103(a) based on a number of grounds. As set forth in detail below, Applicants respectfully submit that these rejections are in error and should be withdrawn.

A. Rejections in view of U.S. Patent No. 4,173,627 (hereinafter "Madrange")

The Office Action has rejected Claims 1-18, 22-32, 36-53, 57-59, 61-62 and 73-83 as allegedly being obvious and unpatentable over the disclosure of Madrange alone and, alternatively, over the disclosure of Madrange further in view of Japanese Patent Abstract JP 08187277 (hereinafter "JP '277"). To that end, it is well established in law that to present a *prima facie* case of obviousness an Examiner is burdened with showing the art relied upon in the rejection teaches, or at least suggests, the claimed invention as a whole. Moreover, the Examiner must also identify the adequate motivation and a reasonable expectation of success for one of ordinary skill in the art to undertake the modifications proposed in the rejection. For the reasons

set forth below, Applicants respectfully submit that the instant rejections fail to satisfy these requirements.

As previously presented, Applicants' independent claims 1 and 80 each recite a composition comprising, in part, at least 10% by weight methyl acetate and 20% to 55% by weight of an alkanol component comprising ethanol. Neither Madrange nor JP '277, alone or in any combination, teach or even suggest this combination much less provide the requisite motivation and expectation of success required to support these rejections.

Madrange discloses a hair care composition containing at least one of: (a) a lower alkanol, such as ethanol, propanol, isopropanol or butanol; (b) a solvent such as 1,1,1-trichloroethane and methylene chloride; and (c) a diluent such as a ketone, in particular acetone and methylethyl ketone; an alkyl acetate, in particular methyl acetate or ethyl acetate, or a hydrocarbon, in particular a C_3-C_7 alkane. Although at least one of the three components (a), (b), or (c) is present in the composition, Madrange makes clear that none of components (a), (b) or (c) is required. *See* Col. 3, lines 48-52. Furthermore, although Madrange does disclose ethanol and methyl acetate individually, it does not teach or suggest the claimed combination of ethanol and methyl acetate.

In support of the rejection, the Examiner again relies initially upon Example 1 of Madrange which discloses an exemplary composition comprised of isobutane and ethanol. In particular, the Examiner suggests it would have been obvious for one of ordinary skill in the art to substitute methyl acetate for the isobutane component because Madrange teaches generally that the diluent can also be methyl acetate. Notably absent from this rejection however is the identification of a suggestion, teaching or motivation that would lead one of ordinary skill in the art to actually make the Examiner's proposed substitution. Applicants do not dispute that Madrange discloses methyl acetate as a possible diluent. What Madrange fails to teach or suggest and therefore the Examiner has failed to establish, is not whether methyl acetate can be used but rather, whether the claimed combination of methyl acetate and ethanol can be used.

The Examiner also relies upon M.P.E.P. section 2123 for the premise that "Patents are Relevant as Prior Art for All They Contain." However, this section is not a license to merely extract two components, namely "methyl acetate" and "ethanol," from a number of possible ingredients and combinations and then suggest they could be combined in a first step toward solving the problem identified by Applicants. In fact, to modify a prior art reference without evidence of such suggestion, teaching or motivation is an impermissible hindsight reconstruction and simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability. Thus, the motivation to modify the teaching of a reference cannot come from the Applicants' own invention. Simply put, there is no teaching or suggestion in Madrange that would motivate one of ordinary skill in the art to arrive at a hair care composition comprising the claimed combination of methyl acetate and ethanol and, as such, any rejection of the instant claims in view of Madrange should be withdrawn.

In an alternative rejection, Claims 1-18, 22-32, 36-53, 57-59, 61-62, and 73-83 were also rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mandrange further in view of JP 08187277 (hereinafter "JP '277"). In particular, the Examiner contends that it would have been obvious for the skilled artisan to utilize the combination of methyl acetate and ethanol in the composition of Madrange because JP '277 teaches that methyl acetate can mask the odor of lower alcohols in a cosmetic composition. To that end, even assuming *arguendo* that one of skill in the art would have combined the disclosures of Madrange and the JP Patent Abstract as proposed in the instant rejection, the combined teachings still fail to arrive at the composition recited in the instant claims wherein the methyl acetate is present in an amount of at least 10 weight percent of the composition.

JP '277 discloses the use of methyl acetate as a masking agent to mask the allegedly irritating odor of an alcohol component in cosmetic compositions. In particular, JP '277 specifically states that "the concentration of the masking agent capable of effectively exhibiting the action is 0.1-10 wt.%, more preferably 0.5-5 wt.% based on the alcohol." Thus, JP '277 teaches that the effective amount of methyl acetate set forth above is determined relative to the

weight of the alcohol component alone and not relative to the total weight of the composition. Furthermore, JP '277 also states that the solvent effect of the lower alcohol component may be compromised if the amount of the masking agent exceeds 10 wt% of the alcohol component and therefore teaches away from using methyl acetate in any amount exceeding 10 wt% relative to the weight of an alcohol component. Since, Applicant's independent Claims 1 and 80 recite compositions comprising 20 wt% to 55 wt% of an alkanol component, the guidance of JP '277 teaches that the highest concentration of methyl acetate that could effectively be used would be 5.5 wt% of the total composition (*i.e.,* 10 % of the 20 wt% to 55 wt% alkanol component). Therefore, even if one of ordinary skill in the art would have combined these teachings as proposed in the rejection, the result would not provide a composition wherein at least 10 wt% of the total composition is methyl acetate as set forth in the instant claims.

In view of the specific limitations on the amount of methyl acetate that JP '277 suggests can be used, the Examiner states that JP '277 is only relied upon for the specific motivation to combine methyl acetate with ethanol in a cosmetic composition and is not relied upon for the weight percentage limitations disclosed therein. This however constitutes an improper selective reading of the reference. It is improper to pick and choose from any one reference only so much of it that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238, 240, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). Therefore, if the Examiner intends to rely upon a reference such as JP '277 for its alleged teaching of methyl acetate in combination with ethanol, the Examiner must view that specific teaching in the context of the reference as a whole. As set forth above, JP '277 explicitly states that the amount of methyl acetate masking agent that can be used to mask the odor of an alcohol in a cosmetic composition should not exceed 10 weight percent of the alcohol component. This specific amount is significantly less than the amount recited in the instant claims, *i.e.,* 10 weight percent of the total composition. To ignore this specific teaching away from the claimed amount of methyl acetate, as the instant rejection purports to do, is again evidence of an improper hindsight rejection.

Furthermore, the current rejections over Madrange alone, or further in view of "JP '277," do not appreciate the several unexpected and superior results achieved by the instant invention. First, by requiring at least 10 weight of methyl acetate, the presently claimed invention achieves the superior advantage of reducing the volatile organic compound content of the hair care composition. A volatile organic compound (VOC) is defined as any compound of carbon, which participates in atmospheric photochemical reactions. See, 40 C.F.R. 51.100 attached as appendix "A". To that end, methyl acetate has been expressly exempted from the list of volatile organic compounds. See, 40 C.F.R. 51.100. Therefore, the inclusion of VOC exempt methyl acetate in the claimed invention necessarily reduces the volatile organic compound content of the composition relative to a composition not containing a VOC exempt component. To this end, neither Madrange nor "JP '277" teach or suggest the desirability of providing a hair care composition that achieves the superior result of lowering the VOC content.

Second, the characteristic, unpleasant, odor associated with alkyl acetates, such as methyl acetate, is acknowledged in the art as a hindrance to consumer acceptance of hair care compositions. To that end, the Applicants have unexpectedly discovered that the unpleasant odor associated with methyl acetate is substantially reduced when combined with ethanol as recited in the present claims. See, attached "Second Declaration of Suzanne Dobbs" previously submitted in parent application number 09/153,644, now U.S. Patent Number 6,752,983. The disclosure of Madrange alone, or in view of JP '277, does not teach or suggest the desirability of providing a combination of components capable of reducing the unpleasant odor associated with methyl acetate. In fact, assuming arguendo that one of ordinary skill in the art would even have been motivated to select methyl acetate from the laundry list of Madrange's possible components, compositions comprising methyl acetate alone or in combination with other components other than ethanol which are disclosed in Madrange (See Col. 3, lines 37-52) do not achieve the same superior and unexpected result of reducing the unpleasant odor associated with methyl acetate. See, attached "Second Declaration of Suzanne Dobbs."

Finally, Applicants have also unexpectedly discovered that ethanol inhibits the detrimental effects that methyl acetate by itself can cause to acetate fabrics. See, attached "Second Declaration of Suzanne Dobbs." Once again, the disclosure of Madrange, alone or in view of JP '277, fails to teach or suggest the desirability of providing a combination of components capable of inhibiting detrimental effects that methyl acetate can have on acetate fabrics. Assuming again for the sake of argument that one of ordinary skill in the art would have even been motivated to select methyl acetate from the laundry list of possible components set forth by Madrange, it has been shown that compositions comprising methyl acetate alone, or in combination with components other than ethanol which are disclosed in Madrange (See Col. 3, lines 37-52) do not achieve the unexpected result of inhibiting the detrimental effects methyl acetate has on acetate fabrics. See, attached Second Declaration of Suzanne Dobbs.

Therefore, not only does Madrange alone, or further in view of JP '277, fail to teach or suggest the claimed invention as a whole, there similarly is no motivation in these references for one of ordinary skill in the art to arrive at a hair care composition that achieves the superior advantages of reducing the volatile organic compound content of the composition, reducing and/or masking the characteristic, unpleasant, odor associate with alkyl acetates, such as methyl acetate, and, inhibiting the detrimental effects that methyl acetate by itself can cause to acetate fabrics. As such, in view of the arguments set forth above, it is respectfully requested that any rejections in view of Madrange alone or further in view of JP '277 should be withdrawn.

Still further, the Office Action has also rejected several dependent claims on a number of grounds. Specifically, Claims 33-35, 56, 60 and 63-72 have been rejected under 35 U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Chaung. Also, Claims 54 and 55 have been rejected under 35 U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Morawsky. To that end, it is axiomatic that dependent claims are non-obvious under section 103 if the independent claims from which they depend are non-obvious. See *In re Fine,* 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Thus, while Applicants do not concede or agree with these rejections, Applicants need not address the substantive merits of these rejections in detail because

the teachings of Madrange alone, and further in view of JP 08187277, are insufficient to defeat the patentability of independent Claims 1 and 80 as discussed above. Accordingly, it is respectfully submitted that dependent Claims 33-35, 54-56, 60 and 63-72 are also allowable over the instant rejections.

B. Rejections in view of U.S. Patent No. 4,243,548 (hereinafter "Heeb")

The Examiner has again rejected Claims 1-18, 27-51, 56-57, 61-68 and 76-83 under 35 U.S.C. §103(a), as allegedly being unpatentable over U.S. 4,243,548, Heeb *et al.*, (hereinafter "Heeb") in view of JP '277.[1] In particular, the Examiner continues to acknowledge that Heeb fails to teach the claimed combination of ethanol and methyl acetate and thus relies upon the disclosure of JP '277 for its specific teaching of a composition comprising both methyl acetate and ethanol as co-solvents. For the reasons set forth below, Applicants respectfully submit that this proposed combination does not render the claimed compositions obvious.

As detailed above, JP '277 specifically teaches that the concentration of methyl acetate that can be used in combination with an alcohol is 0.1-10 wt. % and more preferably 0.5-5 wt. %, based upon on the amount of alcohol present in the composition. Thus, JP '277 teaches that the effective amount of methyl acetate set forth above is determined relative to the weight of the alcohol component alone and not relative to the total weight of the composition. Furthermore, JP '277 also states that the solvent effect of the lower alcohol component may be compromised if the amount of the methyl acetate exceeds 10 wt% and therefore teaches away from using methyl acetate in any amount exceeding 10 wt% relative to the weight of an alcohol component. Thus, following the guidance of JP '277, the highest concentration of methyl acetate that could effectively be used in the Applicant's composition would be 5.5 wt% of the total composition (10 % of the 20 wt% to 55 wt% alkanol component) and not 10 weight percent as suggested in the rejection. Therefore, even if one of ordinary skill in the art would have combined these teachings

[1] Applicants note that the Office Action initially indicates in the second paragraph of page 15 that the rejections over the Heeb reference are withdrawn in light of applicants' arguments. However, the subsequent text of the Office Action continues to set forth grounds for rejection over Heeb in contradiction to the stated withdrawal of rejections. Accordingly, for purposes of this submission, applicants assume the Examiner's initial indication of withdrawal was in error.

as proposed in the rejection, the result would not provide a composition wherein 10 wt% of the composition is methyl acetate as set forth in the instant claims.

Applicants would again note that any reliance upon JP '277 for its alleged teaching of methyl acetate in combination with ethanol must view that specific teaching in the context of the reference as a whole. The Examiner cannot properly select only those portions of a reference that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. Therefore, if one of ordinary skill in the art were to seek the guidance of JP '277 for the combination of methyl acetate and alcohol as suggested in the rejection, the skilled artisan would only have been motivated to use the methyl acetate in the manner and amount described therein. To that end, JP '277 explicitly teaches a maximum amount of methyl acetate that can be used in combination with an alcohol without compromising the solvent effect of the alcohol. This specified amount does not exceed 10 weight percent relative to the amount of alcohol and is significantly less than the amount recited in the instant claims, *i.e.,* 10 weight percent of the total composition. Therefore, for at least this reason, the combined teachings of Heeb and JP '277 do not render the compositions of Applicant's claims obvious and the instant rejections should be withdrawn.

Furthermore, the current rejections over Heeb in view of "JP '277" also fail to appreciate the several unexpected and superior results achieved by the instant invention and set forth in the attached "Second Declaration of Suzanne Dobbs." First, neither Heeb nor JP '277 teach or suggest the desirability of providing a combination of components capable of reducing the unpleasant odor associated with methyl acetate. Heeb discloses a formulation comprising at least one of 23 possible solvents that can be used alone or in combination. Assuming for the sake of argument that one of ordinary skill in the art would have been motivated to select methyl acetate from the laundry list of possible components, these purported compositions comprising methyl acetate alone or in combination with other components disclosed in Heeb (See Col. 2, lines 50-60) do not achieve the unexpected result of reducing the unpleasant odor associated with methyl acetate. See, attached Second Declaration of Suzanne Dobbs. Similarly, JP '277 is directed to

masking the unpleasant odor associated with ethanol and does not suggest the desirability of masking the unpleasant odor associated with methyl acetate.

Second, Applicants have also unexpectedly discovered that ethanol inhibits the detrimental effects that methyl acetate by itself can cause to acetate fabrics. See, attached Second Declaration of Suzanne Dobbs. Once again, neither Heeb nor JP '277 teach or suggest the desirability of providing a combination of components capable of inhibiting detrimental effects that methyl acetate can have on acetate fabrics.

Therefore, not only does Heeb in view of JP '277 fail to teach or suggest a hair care composition providing the unexpected and superior results set forth above, but there similarly is no motivation for one of ordinary skill in the art to arrive at a hair care composition that achieves these superior and unexpected advantages. As such, in view of the arguments set forth above, it is respectfully requested that any rejections over Heeb further in view of JP '277 be withdrawn.

CONCLUSION

In view of the Amendments and Remarks set out above, it is respectfully asserted that the rejections set forth in the Office Action of November 2, 2007 have been overcome and that the application is now in condition for allowance. Accordingly, Applicants respectfully seek notification of same.

Payment in the amount of $1050.00, for a Three-Month Extension of Time representing the fee under 37 C.F.R. § 1.17(A)(3) is being submitted herewith via EFS-WEB. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

/Brian C. Meadows/

Brian C. Meadows
Registration No. 50,848

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted by EFS-WEB on the date indicated below:

/Brian C. Meadows/ — May 2, 2008

Brian C. Meadows — Date